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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,016	12/03/2003	Robert M.H. Dunn	CA920030030U1	4460
58139	7590	07/25/2008	EXAMINER	
IBM CORP. (WSM) c/o WINSTEAD SECHREST & MINICK P.C. P.O. BOX 50784 DALLAS, TX 75201			ALMATRAHI, FARIS S	
ART UNIT	PAPER NUMBER			3627
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07/25/2008	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,016	<b>Applicant(s)</b> DUNN ET AL.
	<b>Examiner</b> FARIS ALMATHRAHI	<b>Art Unit</b> 3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 April 2008.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-28 is/are pending in the application.  
 4a) Of the above claim(s) 1-18 and 28 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/0256/06)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Status of the Application***

1. This action is in reply to applicant amendment filed April 10, 2008.
2. Claims 29, 21-24, and 27 have been amended.
3. Claims 1-28 are pending in this application.
4. Claims 1-18 and 28 remain withdrawn from consideration in this application due to restriction requirement.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A single claim which claims both a system and the method steps is rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101. Claim 21 is directed to a method and overlaps disclosure of "means for" language directed to a system "each fulfillment centre objects comprises means for representing inventory and fulfillment center priority".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 19-27** rejected under 35 U.S.C 103(a) as being unpatentable over Hirth et al. (US Publication No. 2003/0171962 A1).

8. Regarding claim 19, Hirth discloses a method for filling orders for items using an order management system, the method comprising the steps of associating one or more items in an order with one of a set of fulfillment centre objects of an order management system for representing one or more fulfillment centres and one or more electronic marketplaces using a release to fulfillment object (Abstract, Paragraphs [0038] – [0041], [0074]), sending fulfillment instructions relating to one or more items associated with one of a first subset of fulfillment centre objects to a corresponding fulfillment centre, wherein the first subset of the fulfillment centre objects being defined for representing corresponding fulfillment centres (Paragraphs [0041] – [0042]), and sending ordering information relating to one or more items associated with one of the second subset of fulfillment centre objects to the corresponding electronic marketplace, wherein the second subset of the fulfillment centre objects being defined for representing

corresponding electronic marketplaces (Paragraphs [0041] – [0043], [0086], [0136] – [0137], [0146]).

9. Although Hirth does not explicitly disclose the second subset of fulfillment centre objects being defined for representing corresponding electronic marketplaces, the difference between packages assigned to external partners and the second subset of the fulfillment centre objects representing an electronic marketplace is only found in the non-functional descriptive material and is not functionally involved in the steps recited. Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

10. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to define the second subset of fulfillment centre objects for representing corresponding electronic marketplaces because the electronic marketplace does not functionally relate to the steps in the method claimed and because the subjective interpretation of the electronic marketplace does not patentably distinguish the claimed invention.

11. Regarding claim 20, Hirth discloses a method in which a release to fulfillment object associated with a selected one of the fulfillment centre objects in the second subset comprise data representations for tracking orders in the electronic marketplace

corresponding to the selected fulfillment centre object (Paragraph [0043], Paragraph [0049], Paragraph [0076]).

12. Regarding claim 21, Hirth discloses a method in which each fulfillment centre objects comprises means for representing one or more inventory and fulfillment center priority (Paragraph [0041]).

13. Regarding claim 22, Hirth discloses a method in which the means for representing one or more inventory and fulfillment centre priority in the second subset of fulfillment centre objects represents one or more of a null inventory and a low fulfillment centre priority (Paragraph [0041], Paragraph [0083]).

14. Regarding claim 23, Hirth discloses a method further comprising the step of pre-selecting items for association with one of the set of fulfillment centre objects based on one or more inventory and fulfillment centre priority (Paragraph [0041], Paragraph [0083] – [0085]).

15. Regarding claim 24, Hirth discloses a method in which the order management system comprises an administrator interface, and the method further comprises the step of an administrator using the administrator interface to confirm or over-ride the pre-selection of items for association with one of the set of fulfillment centre objects (Figure 5, Paragraph [0088]).

16. Regarding claim 25, Hirth discloses a method further comprising the step of grouping items and in which the step of sending ordering information further comprises maintaining the grouping of the items when information corresponding to the grouped

items is sent to the corresponding electronic marketplace (Paragraph [0010], Paragraphs [0053] – [0055]).

17. Regarding claim 26, Hirth discloses a method in which the step of grouping items comprises grouping the items corresponding to the order from which the items were received by the order management system (Paragraph [0054]).

18. Regarding claim 27, Hirth discloses a method in which the step of grouping items comprises grouping the items corresponding to an aggregation of items from a single order received by the order management system (Abstract, Paragraph [0010]).

#### **Response to Arguments**

19. Applicant's arguments with respect to 35 U.S.C. 102(e) rejections have been considered but are moot in view of the new ground(s) of rejection.

#### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faris Almatrahi whose telephone number is (571)270-3326. The examiner can normally be reached on Monday to Friday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627

Faris Almatrahi  
Examiner  
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FA

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